

REMARKS/ARGUMENTS

Reconsideration of this patent application is respectfully requested in view of the foregoing amendments, and the following remarks. The specification and claims 1, 4, and 8 have been amended. Claims 9-14 have been canceled. No new matter has been added.

The Examiner rejected claims 1, 4 and 8-13 under 35 U.S.C. §112 for failing to comply with the written description requirement. Applicants have amended the specification and claims to delete reference to the "flattened regions" and to recite instead "contact areas". The specification and claims have also been amended to describe the contact areas as having one contact regions or two contact regions that lie opposite one another and reach over their axial length, wherein the radially outer surface of the contact regions has a lesser radial distance from the longitudinal axes of the sleeves than the radially outer surface of the rest of the sleeve surface. This is shown in the drawings, for example in FIGS. 5-7, 9-11 and 13-15.

The Examiner also rejected claims 1, 4 and 8-13 under 35 U.S.C. 112 as being indefinite. Applicants have amended claims 1, 4 and 8 to further clarify the invention.

The Examiner rejected claims 1 and 9 under 35 U.S.C. §103 as being unpatentable over *Kodama* in view of *Burch* and *Hill* and further in view of *Oh*. Claim 8 is rejected as being unpatentable over *Kodama* in view of *Burch*, *Hill*, *Oh* and further in view of *Field*. Claims 10-13 are rejected over *Kodama*, *Burch*, *Hill*, *Oh* and further in view of *Dickmann et al.* Claim 4 is rejected as being unpatentable over *Kadama*, *Burch*, and *Gobbels* and further in view of *Oh*. Applicants respectfully traverse.

Fig. 2 of *Oh* shows a cylinder sleeve that has a sleeve wall having a constant thickness over its circumference and a roughening that has a constant depth, in cross-section. It is true that the formed-on parts 5 (lugs) have a height L_1 , according to the description of Fig. 1, that varies between 0.7 mm and 1 mm. However, according to Fig. 1, a longer formed-on part regularly alternates with a shorter formed-on part. According to Fig. 1, multiple short or longer formed-on parts

are not disposed one behind the other. And Fig. 1 also does not show that the length L_1 of the formed-on parts increases, step by step, from one formed-on part to another, seen over the circumference of the sleeve, so that a non-cylindrical outer surface results, on the basis of a variable depth L_1 of the roughening. The special shape of the formed-on parts 5 has the sole purpose, according to *Oh* (see Summary of the invention) to "provide a cylinder liner wherein the cylinder liner and cylinder block are tightly secured to a base metal to restrict deformation of a cylinder bore and abrasion of a piston and a piston ring to reduce consumption of oil, thereby effectively preventing damage of an engine in the long run."

There is no indication in the entire *Oh* patent that the sleeve should be given a shape other than a cylindrical one.

Regarding *Hill*, the cross-sectional shape, which is elliptical, of the outer part of the sleeve shown here is achieved by means of a corresponding variation in the sleeve wall thickness. (Column 3, line 26, 27). There is no indication in the entire patent that the sleeve should be given a roughened outer shape. One would not think to create a

roughened surface on a sleeve having an elliptical outer shape on the basis of the *Oh* and *Hill* patents, whereby this elliptical outer shape is achieved by means of a variable depth of the roughening of a roughened outer shape. Without knowledge of the present invention, it is by no means obvious for a person of average skill in the art to combine the *Hill* and *Oh* patents with one another, and with *Kodama* and *Burch*, in order to arrive at an invention according to claim 1 of the present patent.

Regarding *Field*, element 112 according to *Field* is not a "step with a flattened region lying radially on the outside" according to claim 8 of the present application, but rather the element 112 is referred to as a "web" in the figure description, the purpose of which consists, according to column 5, line 33 to 35, in that "liners 102 comprise webs 112 which also serve to enhance the rigidity of a cylinder block incorporating the cylinder liner insert 100."

According to the figures in *Field*, this is a continuous connection between the sleeves, and not separate formed-on parts having flattened outer contours, the purpose of which consists in ensuring that the sleeves always assume a clearly defined

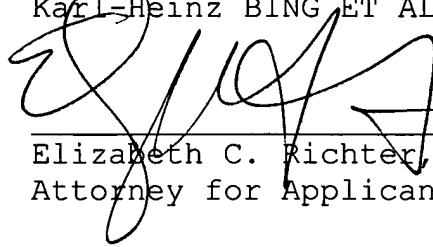
position relative to one another when they are pushed onto barrels, as is also explained in the figure description of the present application.

Regarding *Gobbels*, the Examiner is correct that the cross-section of the outer shape of the sleeve shown in Fig. 4 can be divided up into four equal arc-shaped segments. However, in Figures 6, 10, and 14 of the present application, it is shown, and in amended claim 4, it is stated, that "the radially outer surface of an arc-shaped segment or two arc-shaped segments that lie opposite one another has a lesser radial distance from the longitudinal axis of the sleeve than the radially outer surface of the other arc-shaped segments." This is an essential element of the present invention, and distinguishes this invention from the *Gobbels* patent, in which all four arc-shaped segments have the same distance from the longitudinal axis of the sleeve.

Since none of the cited references have the feature of the radially outer surface of a contact area or two contact areas that lie opposite one another having a lesser radial distance from the longitudinal axis of the sleeve than the radially outer surface of the rest of the sleeve, Applicants submit that claims

1, 4 and 8 are patentable over the cited references, taken either singly or in combination. Early allowance of the amended claims is respectfully requested.

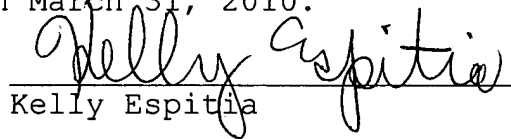
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